

REMARKS

This response is filed with a "request for continued examination" and is deemed fully responsive to the April 7, 2003 office action. Claims 21-34 stand pending in this application. Claims 23, 24, 26, 28 and 34 are amended to more clearly recite elements of these claims, or to make typographical corrections; no new matter is added.

Claim Rejections under 35 USC § 102(e)

Claims 21 and 26-28 stand rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,013,007 ("Root"). Applicants respectfully disagree. To anticipate a claim, the reference must teach every element of the claim and "the identical invention must be shown in as complete detail as contained in the ... claim." *MPEP 2131* citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Root does not teach every element of claims 21, 26-28. Claim 21 requires the following elements:

- (A) a base station for displaying at least one performance metric;
- (B) one or more mobile sensing units for attachment with participants in a competitive event; and
- (C) at least one relay unit for receiving data representing the at least one performance metric from the sensing units and for transmitting said received data to the base station

Among other reasons, Root does not teach or suggest any relay units. The Examiner admits as much on page 3 of the pending action. In Applicants' specification, a relay unit receives radio data (see page 14, lines 1-5). The Examiner refers col. 2, lines 60-62; however this discloses utilizing waypoints obtained by the same GPS receiver worn by the athlete in Root FIG. 2. There is no other place within root that instead teaches such a relay unit. Accordingly, Root cannot anticipate claim 1 since, among other reasons, it does not teach every element. Reconsideration of claim 1 is requested.

Serial No. 09/607,678

Amendment and Remarks responsive to

Office Action mailed April 7, 2003

Page 4

Claims 26-28 depend from claim 21 and benefit from like arguments – though these claims also have other features that patentably distinguish over Root. For example, Root does not, in fact, teach displaying data on a scoreboard (claim 26). The Examiner refers to col. 4, lines 8-14 of Root; however this section only teaches displaying device options on a display – not a scoreboard with a scoreboard that is separate from the base station, as in amended claim 26. A similar argument is provided with amended claim 27. Reconsideration is requested for claims 26-28.

Claim Rejections - 35 USC § 103

Claim 22 stands rejected under 35 USC § 103(a) as being unpatentable over Root in view of U.S. Patent No. 5,420,828 (“Helmsderfer”) and U.S. Patent No. 5,420,828 (“Geiger”). Applicants respectfully disagree, and further believe that Root, Helmsderfer and Geiger do not render claim 22 *prima facie* obvious, as explained below.

The following is a quotation from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP, §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

We already argued that Root does not teach the elements of claim 21. Helmsderfer and Geiger are cited for purposes of the "camera", while Geiger is cited for purposes of sending data. Nonetheless, among other reasons, Root, Helmsderfer and Geiger do not, at all, teach or suggest

a relay unit as claimed. Therefore, this rejection fails 35 U.S.C. §103 in that not all elements are taught. The references are also non-analogous art, and cannot be reasonably combined to render claim 22. We disagree it would be obvious to a skilled artisan to modify Root, Helmsderfer and Geiger to render claim 21, and specifically request evidence of how this may be done pursuant to MPEP 2144.

Claim 23-24 stand rejected under 35 USC § 103(a) as being unpatentable over Root in view of U.S. Patent No. 5,396,429 ("Hanchett"). Applicants respectfully disagree, and further believe that Root and Hanchett do not render claims any of claims 23-24 *prima facie* obvious, as explained below.

We already argued that Root does not teach the elements of claim 21 – that claim 21 itself requires a relay unit and that Root fails to teach or suggest this element. Hanchett also does not teach or suggest features of claims 22-23 in the context of claim 21. Hanchett is also non-analogous art to Root. We disagree it would be obvious to a skilled artisan to modify Root and Hanchett to render claims 22-23, and specifically request evidence of how this may be done pursuant to MPEP 2144.

Claim 29-34 stand rejected under 35 USC § 103(a) as being unpatentable over Root in view of U.S. Patent No. 6,163,021 ("Michelson"). Applicants respectfully disagree, and further believe that Root and Hanchett do not render claims any of claims 29-34 *prima facie* obvious, as explained below.

We already argued that Root does not teach the elements of claim 21 – that claim 21 itself requires a relay unit and that Root fails to teach or suggest this element. Root in combination with Michelson also does not teach or suggest features of claim 21. Michelson is also non-analogous art to Root. We disagree it would be obvious to a skilled artisan to modify Root and Hanchett to render claims 29-34, and specifically request evidence of how this may be done pursuant to MPEP 2144. Root and Michelson simply do not teach the elements of claims 29-34, each of which depends from claim 21. Moreover, the Examiner cites Michelson seemingly because it teaches a navigation system for spinning projectiles; however we ask that

the Examiner again review claims 29-34 and then Michelson because Applicants' claims 21, 29-34 are simply not shown by Root and/or Michelson. Michelson teaches a magnetic spin sensor; however nothing in Michelson teaches the elements of claims 21 and 29-34. More particularly, Mickelson concerns a navigation system for spinning projectiles; it is not analogous art and also fails to recite the key elements of claim 21: performance metric, relay units, mobile sensing units, etc. Reconsideration and allowance is requested for each of claims 29-34.

Claim 25 stands rejected under 35 USC § 103(a) as being unpatentable over Root in view of Hanchett and U.S. Patent No. 5,993,335 ("Eden"). Applicants respectfully disagree, and further believe that Root, Hanchett and Eden do not render claim 25 *prima facie* obvious, as explained below.

We already argued that Root and Hanchett do not teach the elements of claim 21. Eden is cited for purposes of the "half pipe". Nonetheless, among other reasons, Root, Hanchett and Eden do not, at all, teach or suggest a relay unit as claimed. Eden does not teach any electronics; it instead teaches a type of hockey arena. It is non-analogous art to Root and Hanchett. Therefore, this rejection fails 35 U.S.C. §103 in that not all elements are taught. The references are also non-analogous art, and cannot be reasonably combined to render claim 25. We disagree it would be obvious to a skilled artisan to modify Root, Hanchett and Eden to render claim 25, and specifically request evidence of how this may be done pursuant to MPEP 2144.

Note that the omission of an element – e.g., mobile sensing units, relay unit, performance data – is an indicia of non-obviousness. *See MPEP 2144.04*. Neither is it "obvious to one of ordinary skill" to modify these references. In several of the above arguments, Applicants specifically request evidence in the prior art to render claim 21; we contend this cannot be done without hindsight. Reconsideration and allowance of all claims 21-34 are requested.

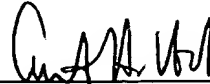
For the reasons discussed above, Applicants believe that amended claims 21-34 are non-obvious in view of the cited references; their reconsideration and allowance are requested.

The \$205.00 fee for a two-month extension has been submitted. It is believed no additional fee is due. If any additional fee is due, please charge Deposit Account No. 12-0600.

Respectfully submitted,

Date: 8 Sept 2003

By:



Curtis A. Vock, Reg. No. 38,356
LATHROP & GAGE L.C.
4845 Pearl East Circle, Suite 300
Boulder, CO 80301
Telephone: (720) 931-3011
Facsimile: (720) 931-3001